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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,588	07/15/2003	Makoto Tsuji	204552029300	6878
25227	7590	04/22/2005		EXAMINER
MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD SUITE 300 MCLEAN, VA 22102			VAN ROY, TOD THOMAS	
			ART UNIT	PAPER NUMBER
			2828	

DATE MAILED: 04/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/618,588	TSUJI, MAKOTO	
	Examiner <i>TM</i> Tod T. Van Roy	Art Unit 2828	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-5 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>07/15/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Masui et al. (US 5557116).

With respect to claim 1, Masui discloses the claimed semiconductor laser device (fig.19) comprising a stem body (fig.12 #77, fig.19 base region unlabeled) having a reference surface (fig.12 #77, fig.19 base region unlabeled, reference surface noted as side containing laser diode element), a heat radiation block (fig.19 #125, #125 being a portion of lead #124 as noted col.16 lines 6-7, and being a lead, inherently has both electrical and thermal conductive and dissipative properties) provided on the reference surface of the stem body and which has a semiconductor laser chip mounted on a side face thereof (fig.19 #121) and a lead which extends through the stem body (fig.19 #126), wherein a portion of the lead protruding on a reference surface side is placed on one side surface of the heat radiation block on which the semiconductor laser chip is mounted (fig.19 #126, located on left side of heat radiation block #125), and the semiconductor laser device further comprises a cover which is fixed to at least one of the heat radiation block and the stem body so as to surround the semiconductor laser chip and the portion of the lead protruding on the reference surface side (fig.19 #131), in

conjunction with the heat radiation block, and which is opened on at least one side of the cover that is a beam-output side of the semiconductor laser chip (fig.19 #131, opened at top portion above laser chip #121 and heat block #125).

With respect to claim 2, Masui discloses the device as outlined in the rejection to claim 1 including the cover being made of a resin material (fig.19 #131, col.16 lines 31-36, where the cover is said to be made of plastic and resin material is known to be a synthetic plastic).

With respect to claim 3, Masui discloses the device as outlined in the rejection to claim 1 above wherein the depth of the cover in the beam output direction of the semiconductor laser chip is substantially equal to a depth of the heat radiation block (fig.19, cover #131 is substantially equal in depth to the height of the heat radiation block #125).

With respect to claim 4, Masui discloses the device as outlined in the rejection to claim 1 above wherein the cover has a recessed portion (fig.31 #158,159) for putting therein a resin for bonding the cover to the heat radiation block (fig.32 #161, the cover #157 contains recessed portions to accept the heat radiation block #154, where #154 consists of a lead connecting to the laser diode, and to the recessed portions, having both electrical and thermal dissipation properties).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 5 rejected under 35 U.S.C. 103(a) as being unpatentable over Masui.

With respect to claim 5, Masui teaches the semiconductor laser device as described in the rejection to claim 1 above, Masui does not teach the heat radiation block to have a recessed portion for putting therein a resin for bonding the cover to the heat radiation block. Although Masui does not teach this arrangement of parts, it is in essence a reversal of the parts outlined in the objection to claim 4. As stated in the MPEP(2144.04 VI)

A):

Reversal of Parts

In re Gazda, 219 F.2d 449, 104 USPQ 400 (CCPA 1955) (Prior art disclosed a clock fixed to the stationary steering wheel column of an automobile while the gear for winding the clock moves with steering wheel; mere reversal of such movement, so the clock moves with wheel, was held to be an obvious expedient.).

In view of this case law, there is no new or unexpected result associated with this arrangement of parts and, in addition, the stated arrangement does not change the operation of the given device so it would have been obvious to one of ordinary skill at the time of the invention to make this change.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 5309460, and US PGPUB 2002/0071461 both read on claims 1-3 of the current application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tod T. Van Roy whose telephone number is (571)272-8447. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minsun Harvey can be reached on (571)272-1835. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2828

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TVR

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MINCUN CHI MURPHY
PRIMARY EXAMINER